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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/402,010 09/28/99 COE

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EXAMINER

COLEMAN, B

ART UNIT

PAPER NUMBER

1624

3

DATE MAILED:

09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/402,010

Applicant(s)

COE et al.

Examiner

Brenda Coleman

Group Art Unit

1624



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 12 is/are allowed.

☒ Claim(s) 1-11, 13, and 14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claims 1-14 are pending in the application.

Priority

1. Any non-provisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross - references to other related applications may be made when appropriate.

“This application is a national stage entry under 35 U.S.C. § 371 of PCT/IB98/01813, filed November 13, 1998 which claims the benefit of U.S. Provisional Application No. 60/070,245, filed December 31, 1997.” is suggested.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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- a) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 (and claims dependent thereon) recite the broad recitation "aryl and heteroaryl groups may optionally be substituted with one or more substituents", and the claims also recite "preferably from zero to two substituents" which is the narrower statement of the range/limitation.
- b) Regarding claims 1 (and claims dependent thereon), the phrase "e.g." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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- c) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 (and claims dependent thereon) recite the broad recitation "monocyclic and bicyclic rings may optionally be substituted with one or more substituents", and the claims also recite "preferably from zero to two substituents for the monocyclic rings and from zero to three substituents for the bicyclic rings" which is the narrower statement of the range/limitation.
- d) Claim 1 is vague and indefinite in that it is not known what is missing from the claim since the claim does not end with a period.

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- e) Claim 2 recites the limitation "(C₀-C₆)alkoxy-(C₀-C₆)alkyl-" in definition of R¹⁰ and R¹⁷. There is insufficient antecedent basis for this limitation in the claim.
- f) Claim 2 recites the limitation "phenyl and monocyclic heteroaryl" in definition of R¹⁰ and R¹⁷. There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 9 is a substantial duplicate of claim 7, as the only difference is a statement of intended use which is not given material weight. Note In re Tuominen 213 USPQ 89.
- h) Regarding claims 9, 10 and 13, the phrase "including but not limited to" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "including but not limited to"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
- i) Regarding claims 9, 10 and 13, the phrase "e.g." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- j) Regarding claims 9, 10 and 13, the phrase "including" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "including"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
- k) Claim 11 is vague and indefinite in that the definitions of R⁵ and R⁶ are "defined as in formula I above", however, they are not defined within the claim.

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- 1) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation "from 1 to 3 halo atoms", and the claim also recites "from 1 to 3 fluoro or chloro atoms" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazzocchi et al., Journal of Medicinal Chemistry. Mazzocchi teaches the compounds of the instant invention where R¹ is -CH₂CH₂-cyclopropyl, -CH₂CH₂CH₃, -CH₂-CH=CH₂ or -CH₂CH=CMe₂. See examples 4c, 4d, 4e or 4f on page 456.

Claim Objections

4. Claim 14 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Allowable Subject Matter

5. Claim 12 is allowed. None of the prior art of record nor a search in the pertinent art area teaches the method of use of 2,3,4,5-tetrahydro-1,5-methano-1H-3-benzazepine as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
September 26, 2000